

REMARKS

Reexamination and reconsideration of this application, as amended, is respectfully requested. Claims 1-20 remain in the application. Applicant believes there is no charge for this response as no new claims have been added.

AMENDMENTS AFTER FINAL ACTION PER 37 C.F.R. §1.116(a)

Applicant appreciates that entry of the amendment shown above is not required as a matter of right. However, in accordance with 37 C.F.R. §1.116(a), Applicant believes that at the amendments place the claims in condition so that they are allowable over the cited patents of record. At the very least, Applicants believe the amendments present the rejected claims in a better form for consideration on appeal. Applicant also believes the amendments only require a cursory review by the Examiner as the amendments include limitations that are similar to limitations that were in independent or dependent claims previously presented and discussed in the response. Accordingly, Applicant respectfully submits that the amendments do not raise issues of new matter and do not require a new search by the Examiner.

Support for Amendments

As indicated above, claims 1, 8, and 18 have been amended. Support for the amendments is shown at least by example illustrated in FIG. 1 and described on page 8, lines 12-21.

Furthermore, the Title of the Specification has been amended to advance the prosecution of the application. However, Applicant would like to point out that the amendment to the title does not narrow or limit the scope of the claims in any way.

Applicant respectfully submits that no new matter has been added.

Response to the 35 U.S.C. §112, Second Paragraph, Rejection

The Office Action rejects claim 5 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicant has amended claim 5 as requested by the Final Office Action.

Response to the 35 U.S.C. §102(b) Rejection

The Office Action also rejects claims 8-9, 13-14 and 17 under 35 U.S.C. §102(b) as being anticipated by Isikoff (US 5,748,084). Applicant respectfully traverses this rejection in view of the amendments above and the remarks that follow.

As is well-established, in order to successfully assert a *prima facie* case of anticipation, the Office Action must provide a single prior art document that includes every element and limitation of the claim or claims being rejected. Therefore, if even one element or limitation is missing from the cited document, the Office Action has not succeeded in making a *prima facie* case.

It is respectfully asserted that, as one example, Isikoff fails to meet either expressly or inherently the limitation that a portable computing device has a modem that

is able to store data that is used in the future by a user with a second processor while first processor is deactivated.

Isikoff makes clear that any activity involving data modem 20 also involves microprocessor 30. Thus, Isikoff cannot teach or suggest storing a communication with a modem when microprocessor 30 is inactive.

In particular, Isikoff states "Once data begins to be received, the microprocessor temporarily stores the data in memory and alerts the host computer: (column 5, lines 46-48) "This information is passed onto the microprocessor which determines what actions need to be taken within the beacon and what signals need to be sent the host computer." (column 5, lines 29-32) "For an incoming voice call the microprocessor alerts the host computer via an interrupt or other hardware notification rout." (column 5, lines 35-36) "Another type of incoming data is that of CDPD cellular packets. Such packets may contain e-mail, pages, etc. and might also contain low and high level control codes. These packets are examined by the microprocessor and passed on to the user interface software." (column 6, lines 55-59, emphasis added)

Furthermore, the data stored by beacon 101 is not used by the user, but rather by the processor of the laptop. Isikoff states "The beacon ... communicates with the laptop computer or various subsystems thereof via a cryptographic exchange to effectively prevent unauthorized removal or bypassing of its security logic." (column 4, lines 3-8)

Accordingly, Applicant respectfully submits that Isikoff does not teach or suggest at least one feature of claim 8. Thus, claim 8, and the corresponding dependent claims, are believed not to be anticipated by Isikoff.

Response to the 35 U.S.C. §103(a) Rejection

The Office Action also rejects claims 1-7, 10-12, and 16 under 35 U.S.C. §103(a) as being unpatentable over Isikoff. Applicant respectfully traverses this rejection in view of the remarks that follow.

1) THE INDEPENDENT CLAIMS INCLUDE LIMITATIONS THAT ARE NOT TAUGHT OR SUGGESTED BY THE COMBINATION OF KURIBAYASHI AND PAIN ET AL.

It is well established that obviousness requires a teaching or a suggestion by the relied upon prior art of all the elements of a claim (M.P.E.P. §2142). Applicants respectfully submit that Isikoff does not meet the requirements of an obvious rejection in that Isikoff neither teaches nor suggests a modem adapted to store at least a portion of a communication in the non-volatile memory when the processor is inactive.

Isikoff makes clear that any activity involving data modem 20 also involves microprocessor 30. Thus, Isikoff cannot teach or suggest storing a communication with a modem when microprocessor 30 is inactive. In addition, Isikoff does not teach that beacon 101 is programmed by a user or that the data retrieved by beacon 101 is used by a user.

Consequently, Isikoff cannot make Applicant's claims 1-7, 10-12, or 16 obvious.

The Final Office Action also rejected claims 18-20 as being obvious in view of a single reference Angelo et al. However, as admitted by the Final Office Action, Angelo

fails to teach or suggest at least one feature of Applicant's claim, and thus, since the rejection is based on a single reference, cannot make Applicant's invention obvious.

Conclusion

The foregoing is submitted as a full and complete response to the Office Action mailed October 2, 2003, and it is submitted that claims 1-20 are in condition for allowance. Reconsideration of the rejection is requested. Allowance of claims 1-20 is earnestly solicited.

Should it be determined that an additional fee is due under 37 CFR §§1.16 or 1.17, or any excess fee has been received, please charge that fee or credit the amount of overcharge to deposit account #02-2666.

If the Examiner believes that there are any informalities which can be corrected by an Examiner's amendment, a telephone call to the undersigned at (480) 554-9732 is respectfully solicited.

Respectfully submitted,

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PATENT APPLICATION

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